REMARKS

Claims 1 and 4-10 are pending in the present application. Claims 1 and 4-10 have been amended to correct typographic errors and/or to further clarify the subject matter recited therein. No new matter is added by the new claim and amendments, which find support throughout the specification and figures. It is respectfully submitted that the amendments do not raise issues requiring additional searching, simplify issues on appeal, and/or place the claims in condition for allowance. Therefore, it is respectfully requested that the amendments be entered. In view of the amendments and the following remarks, favorable reconsideration of this application is respectfully requested.

The Examiner objects to claims 4-10 based on informalities. The preambles 4, 6, and 7 are amended to begin with "The" rather than "A", and claims 5 and 8-10 are amended to remove the use of the word "may". Therefore, it is respectfully requested that the objections to the claims be withdrawn.

Claims 4 is rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner asserts that claim 4 is inconsistent with a feature of claim 1 by stating that the point degree to be displayed is equal to zero, whereas claim 1 states that the point degree does not decrease to zero (Office Action; page 3, lines 21-24). However, claim 1 states that the display point degree ***does not decrease to zero for the subsequent display*** of the advertisement information ***in response to the customer first selecting the advertisement***, and therefore does not indicate that the point degree ***never*** decreases to zero. Claim 4 recites that "a minimum value of the point degree to be displayed is equal to 0", which is consistent with the feature of claim 1 relating to the adjustment to the display point degree for the first selection of the advertisement.

Therefore the claims are not inconsistent as presented and Applicant respectfully requests that the rejections be withdrawn.

Claims 1 and 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. Patent 5,794,210 to Goldhaber (hereinafter referred to as Goldhaber) in view of PCT Application No. WO 98/34189 to Roth et al. (hereinafter referred to as Roth). Applicants respectfully traverse.

Claim 1 relates to an advertisement supplying system for displaying a point which gives viewing persons an incentive to view an advertisement in combination with advertisement information on a terminal apparatus connected thereto via a computer network. The system of claim 1 includes, *inter alia*, storage means for storing thereinto identification information of a customer and a point degree owned by the customer in relation to each other, and display point degree determining means for determining a display point degree to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer and the display point degree with reference to a predetermined rule. In the system of claim 1, said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information, and ***the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement.***

The Examiner admits that Goldhaber does not disclose the feature of claim 1 of "the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement" (Office Action; page 9, lines 14-17). The Examiner asserts that this feature is disclosed in Roth, and discusses the

features of the instant claims at page 14 of the Office Action, which cites to Roth (Roth; page 26, line 6 to page 29, line 4 and figures 5 and 6). The cited sections of Roth apparently discuss bidding on advertisements for viewers, and mentions advertisement rotation, advertisement frequency, and repeat viewers. However, the cited sections and figures of Roth do not give any disclosure or suggestion regarding the display of an advertisement ***to the customer for a subsequent viewing***, nor more particularly such display ***after a first selection***. The Examiner further cites to Roth as disclosing a bid for a view opportunity going from 5 cents per view to 1 cent per view (Roth; page 3, line 19 to page 4, line 10). However, this section of Roth does not relate to the same viewer, but instead discusses the first thousand viewings being valued at 5 cents and subsequent viewings being valued at 1 cent. There is no mention that the first thousand or the subsequent viewings are ***by the same customer***. In contrast, the present invention discusses ***the change in a display point degree for a customer***. Therefore Roth does not disclose or suggest this feature of claim 1.

Additionally, Applicants respectfully submit that there is no proper motivation to combine Roth and Goldhaber. The motivation to combine the references provided in the Office Action is apparently a restatement of the advantages of the present invention (Office Action; page 14, line 21 to page 15, line 11). The Office Action merely states that an ordinarily skilled artisan would have been motivated to display an ad to a user more than once until the user responds to the ad. However, this conclusory reasoning is insufficient to support a claim of obviousness. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either ***explicitly or implicitly in the references themselves or in the knowledge generally available*** to one of ordinary skill in the art. (MPEP 2143.01, emphasis

added). "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

It is respectfully submitted that the present rejection does not provide a proper motivation to combine the references since it does not show why a person of ordinary skill in the art would choose to combine the two distinct references, ***in the particular manner claimed***. Roth relates to an internet advertisement system, while Goldhaber relates to an attention brokerage system. However, there is no motivation in Roth to suggest a combination with Goldhaber, or vice versa. There must be ***specific teaching*** to motivate a person of ordinary skill in the art to combine the prior art teachings ***in the particular manner claimed***. Therefore, since there is no motivation to combine the references, the rejection is improper and should be withdrawn.

Claims 4 and 7 depend from claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable.

Claims 5 and 8-10 include features similar to those discussed above in regard to claim 1, and therefore these claims are allowable for at least the same reasons as claim 1 is allowable.

Claim 6 depends from claim 5 and is therefore allowable for at least the same reasons as claim 5 is allowable.

CONCLUSION

However, if for any reason the Examiner should consider this application not to be in condition for allowance, he is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

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Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,

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